

## **REMARKS**

Claims 1, 3, 14, 16, 24, and 26 - 27 have been amended. No new matter has been introduced with these amendments, all of which are supported in the application as originally filed. Claims 1, 3, 5 - 21, and 24 - 27 remain in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, and claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

### **I. Rejection under 35 U. S. C. §101**

Page 2 of the Office Action dated April 16, 2009 (hereinafter, the Office Action) states that Claims 1, 3, 5 - 21, and 24 - 26 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Applicants have amended independent method Claims 1, 14, and 24 herein to recite “using programming code of a computer”. See, for example, lines 11, 14, 17, and 21 of Claim 1. Accordingly, it is clear that the methods cannot be carried out solely by the human mind, and the claims “positively recite” use of a machine.

Furthermore, each of these claims recites a “transform[ation] of a particular article to a different state or thing”. For example, assigned attribute values are transformed into a product assessment score (i.e., by summing those assigned attribute values; see, for example, lines 11 - 12 of Claim 1). The claims also recite transforming the assigned attribute values and a threshold value into a revised product assessment score for each attribute for which the assigned attribute value falls below the threshold value (see, for example, lines 16 - 19 of Claim 1, referring to using the threshold value as a replacement in the summing). In this scenario, the claims also recite transforming the revised product assessment score and the product assessment score into a product assessment score increase (see, for example, lines 19 - 20 of Claim 1, referring to subtracting).

In view of the above, Applicants respectfully submit that independent method Claims 1, 14, and 24 meet *both* prongs of the test set out in the carryover paragraph on pages 2 - 3 of the Office Action. Therefore, these claims are directed to statutory subject matter. Dependent Claims 3, 5 - 13, 15 - 21, and 25 are therefore deemed to recite statutory subject matter as well.

With regard to independent system Claim 26, Applicants respectfully traverse the §101 rejection as presented on page 4 of the Office Action. The Office Action states therein “Claim 26 recites functional descriptive material (i.e. a computer program) ...”. This is not correct. Claim 26 recites a “... system comprising a computer and instructions which are executable, using a processor of the computer, to perform ...”. See Claim 26, lines 2 - 3 (emphasis added). Accordingly, Applicants respectfully submit that Claim 26 recites statutory subject matter as

currently presented.

In view of the above, the Examiner is respectfully requested to withdraw the §101 rejection.

II. Rejections under 35 U. S. C. §103(a)

Page 4 of the Office Action states that Claims 1, 3, 7 - 17, 21, and 24 - 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2002/0184082 to Nakano. Page 10 of the Office Action states that Claims 5 - 6 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano in view of U. S. Patent Publication 2004/0068456 to Korisch. Page 11 of the Office Action states that Claims 18 - 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakano in view of Lowe, “QFD in New Product Technology Evaluation” (hereinafter, “Lowe”). These rejections are respectfully traversed with regard to the claims as currently presented.

Applicants have amended Claim 1 herein to clarify the claim language pertaining to the product assessment score and the increase to that score (“product assessment score increase”). For each of the attributes used for computing the product assessment score, if the assigned attribute value for that attribute falls below a threshold value, then a revised product assessment score is computed by replacing the assigned attribute value with the threshold value when summing the assigned attribute values. The product assessment score increase computation then subtracts the product assessment score from this revised product assessment score.

With reference to the sample results in Applicants' **Fig. 9**, for example, the assessed "Product XYZ" has received a product assessment score of 87.65% (see reference number **910**). A "Complete Software Solution" attribute **921** has received a score (or "assigned attribute value") of 2. The threshold value, however, is 3.<sup>1</sup> Thus, the assigned attribute value for this attribute **921** "falls below a threshold value". Accordingly, a computation is performed to determine what the product assessment score for Product XYZ would be if attribute **921** had received a value of 3 instead of the value of 2, and the increase to the product assessment score resulting from this increase in the assigned attribute value can then be determined. This is stated in **Fig. 9** as "Impact to score if brought to minimum", and this impact ("product assessment score increase") is shown in **Fig. 9** as .67%.<sup>2</sup>

As currently presented, the claim elements on lines 11 - 20 of independent Claim 1 recite:

using programming code of a computer to programmatically compute a product assessment score, for the IT product, by summing the assigned attribute values;

for each of the attributes for which the assigned attribute value falls below a threshold value, using programming code of the computer to programmatically compute a product assessment score increase that will result by raising that assigned attribute value to the threshold value, the programmatically computing a product assessment score increase comprising using programming code of the computer to compute a revised product assessment score for the IT product using the threshold value as a replacement for the assigned attribute value of the attribute in the summing and then subtracting the product assessment score from the revised product assessment score (emphasis added)

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<sup>1</sup> See Specification, p. 29, paragraph that begins "A summary 920 is provided ...". As stated therein, the "minimum acceptable score" for the attributes is preferably "a 3 on [a] 5-point scale".

<sup>2</sup> *Id.*

Applicants respectfully submit that Nakano does not teach, or suggest, this claim language. Referring to paragraphs [0048] - [0068] of Nakano, which were cited in the Office Action for teaching the claim elements on lines 11 - 20 of Claim 1 as previously presented, Applicants find equations for computations used by Nakano in paragraphs [0049], [0052], [0056], [0059], [0063], and [0067]. Another equation is presented in paragraph [0073]. These equations will now be discussed, demonstrating that they fail to disclose the approach recited on lines 11 - 20 of Applicants' Claim 1.

With regard to the equation in paragraph [0049], Applicants note that the introductory material in paragraph [0048] refers to the equation as a "linear equation". As is well known, a linear equation is quite different from the computations set out in Applicants' claim language. A linear equation is plotted in 2-dimensional space as a line, for example, having a slope and an intercept value. (See <http://mathworld.wolfram.com/LinearEquation.html>.) It can also be seen, by reference to the equation in paragraph [0049], that various multiplication and division operations are defined therein. This is different from the computations performed according to Applicants' Claim 1.

The equations in paragraphs [0052], [0056], [0059], [0063], [0067], and [0073] also use various multiplication and division operations; accordingly, these equations are also different from the computations performed according to Applicants' Claim 1.

Section 2143.03 of the MPEP, "All Claim Limitations Must Be Considered" (which is

found within Section MPEP §2143, titled “Examples of Basic Requirements of a *Prima Facie* Case of Obviousness”), quotes *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which held that “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added). Applicants respectfully submit that, when considering all of the words in Claim 1, as required by MPEP §2143.03, it can be seen that Nakano does not disclose what Applicants have claimed. Applicants also respectfully submit that neither Korisch nor Lowe cures the above-discussed defects of Nakano.

In addition, Applicants hereby request that the Examiner provide an affidavit under 37 CFR 1.104(d)(2) to support the assertion on page 7 of the Office Action that it “would have been obvious to perform the claimed limitation via gap analysis in order to achieve the target product characteristic values taught by Nakano”.

In view of the above, Applicants respectfully submit that their independent Claim 1 is patentable over Nakano and/or Official Notice. Independent Claims 14, 24, and 26 - 27 recite claim language similar to that which has been discussed above with regard to Claim 1, and these claims are therefore deemed patentable by the same arguments presented above with regard to Claim 1. Dependent Claims 3, 5 - 13, 15 - 21, and 25 are therefore deemed patentable by virtue of, *inter alia*, the patentability of the independent claims from which they depend.

The Examiner is therefore respectfully requested to withdraw the §103 rejections of all claims as currently presented.

III. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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